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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,676	09/04/2001	Heinz-Ulrich Diestelhorst	MFA-13302/04	7054
25006	7590	08/24/2004	EXAMINER	
GIFFORD, KRASS, GROH, SPRINKLE ANDERSON & CITKOWSKI, PC 280 N OLD WOODARD AVE SUITE 400 BIRMINGHAM, MI 48009			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	
DATE MAILED: 08/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,676

Applicant(s)

DIESTELHORST ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) 11, 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 11, 13 and 14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office action acknowledges the applicant's Amendment submitted 13 May 2004. Claims 1-9 and 11-16 are pending in the application. Claim 11, 13, and 14 are withdrawn from further consideration as being directed to a non-elected species. Claims 10 and 17 have been cancelled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

3. In light of the applicant's amendment, the objection to the abstract is hereby withdrawn.

Claim Objections

4. In light of the applicant's amendment, the objection to the claims is hereby withdrawn.

Claim Rejections - 35 USC § 112

5. In light of the applicant's amendment, the rejection of claims 1-9, 12, 15, and 16 under 35 USC 112, second paragraph, is hereby withdrawn.

Claim Rejections - 35 USC § 102

6. Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Schweinsberg (EP 0 289 698 A2).

The examiner notes that the applicant does not positively claim the flat housing or the carrier.

Schweinsberg discloses a coupling member (60, Figures 6-8). The coupling member of Schweinsberg is capable of functioning as claimed by the applicant.

Claim Rejections - 35 USC § 103

7. Claims 1, 2, 8, 9, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gloger (US 5,676,246) in view of Schweinsberg.

Since the examiner is required to interpret the claims in the broadest reasonable sense, in all cases of broader limitations followed by narrower limitations, the examiner interprets the broader limitation to be the structure claimed by the applicant.

Regarding claim 1, Gloger '246 discloses an apparatus for storing disk-shaped storage media with a flat housing (10) and a slot opening (22).

Gloger '246 lacks or does not expressly disclose a coupling member.

Schweinsberg discloses a coupling member (60, Figures 6-8) for coupling a media storage disk to a carrier. Schweinsberg discloses coupling elements (80, 82), which can be connected to a carrier (see Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the housing of Gloger '246 with a coupling member as taught by Schweinsberg in order to retain

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several disks within a single package. The assembly of Gloger-Schweinsberg is capable of functioning as claimed by the applicant.

As to claim 2, the assembly of Gloger-Schweinsberg is releasably connected to a carrier through pins (Schweinsberg 80, 82).

As to claim 8, the slot of the assembly of Gloger-Schweinsberg is closed when the coupling member is inserted.

As to claim 9, the assembly of Gloger-Schweinsberg discloses an abutment edge (Schweinsberg, lower bound of slots 72 and 74).

As to claim 12, the assembly of Gloger-Schweinsberg discloses coupling elements (Schweinsberg 80, 82), which can be connected to a carrier (see Schweinsberg, Figure 1). The coupling member remains in one piece during this process.

As to claim 15, the assembly of Gloger-Schweinsberg discloses the claimed invention except for the coupling member made of a reusable material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the coupling member of Gloger-Schweinsberg in a reusable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

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8. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gloger-Schweinsberg as applied to claim 1 above, and further in view of Saito (US 4,476,978).

Regarding claim 3, the assembly of Gloger-Schweinsberg discloses the claimed invention except for the semi-circular cutout. Saito discloses a coupling member (17) with a semi-circular cutout. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the assembly of Gloger-Schweinsberg with a semi-circular cutout as taught by Saito in order to reduce the overall length of the assembly.

As to claims 4-7, the assembly of Gloger-Schweinsberg-Saito discloses the claimed latching arrangement (see Saito, Figure 3a).

Response to Arguments

9. Applicant's arguments filed 13 May 2004 have been fully considered but they are not persuasive.

10. In response to applicant's argument, concerning claim 16, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the flat housing and the carrier) are not positively recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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11. In response to the applicant's arguments that Gloger-Schweinsberg does not disclose a coupling element latched to the housing, the examiner contends that a friction-fit connection meets the definition of "releasably latchable".

12. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

13. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching can be found in Schweinsberg (see, for example, Figures 1-8).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

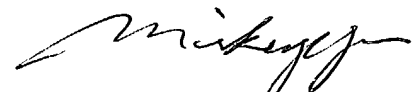
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory Pickett
Examiner
9 August 2004


Mickey Yu
Supervisory Patent Examiner
Group 3700